APPELLANT'S PRE-APPEAL BRIEF REQUEST FOR REVIEW
Response Under 37 CFR 1.116
Expedited Procedure
Examining Group 2621
Application No. 09/937,460
Paper Dated: January 9, 2008
In Reply to Final Rejection Dated August 10, 2008
Attorney Docket No.: 3135-011614

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.	:	09/937,460			
Appellant	:	Pieter Tjerk Koopman			
Filed	:	December 28, 2001			
Title	:	DEVICE AND METHOD FOR SELECTING AND RECORDING AN IMAGE			
Art Unit	:	2621	Confirmation No	:	9480
Examiner	:	Shawn S. An	Customer No.	:	28289

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

For the reasons set forth herein, the Appellant respectfully submits that the final Office Action dated August 10, 2007 is based on improper rejections of the claims and does not establish the asserted *prima facie* case of obviousness based on the cited references. A Notice of Appeal and Petition for a two-month Extension of Time are submitted herewith.

I hereby certify that this correspondence is being electronically submitted to the United States Patent and Trademark Office on the date below.

Judy Eberle
(Name of Person Mailing Papers)

Judy Eberle — January 9, 2008
Signature — Date

I. Rejection of claims 22, 24, 26-29, 32-34, 36, 40 and 42 under 35 U.S.C. §103(a) for obviousness over United States Patent No. 4,175,860 to Bacus, United States Patent No. 4,741,043 to Bacus and United States Patent No. 5,134,662 to Bacus et al.

Independent claims 22 and 36 stand rejected under 35 U.S.C. §103(a) as being obvious over United States Patent No. 4,175,860 to Bacus (hereinafter "the '860 Bacus patent"), United States Patent No. 4,741,043 to Bacus (hereinafter "the '043 Bacus patent") and United States Patent No. 5,134,662 to Bacus et al. (hereinafter "the '662 Bacus patent"). The combination of the '860 Bacus patent, '043 Bacus patent and the '662 Bacus patent fails to address each and every limitation of independent claims 22 and 36, thereby resulting in a clear deficiency in establishing a *prima facie* case of obviousness in support of the rejection of these claims.

A. No teaching or suggestion of an immovable object holder for positioning an object in a stationary position

The '860 Bacus patent, the '043 Bacus patent and the '662 Bacus patent, either alone or in combination, do not teach or suggest an ***immovable*** object holder for positioning the object ***in a stationary position*** as required by independent claims 22 and 36. Instead, these references disclose that it is the standard, in microscopy, to move the object and keep the imaging equipment stationary. This is opposite to the claimed invention, wherein the object remains stationary and the at least one displaceable mirror moves. The advantage of holding the object on an immovable object holder in a stationary position is that it simplifies construction, thereby saving costs over comparable systems.

Each of the Bacus patents requires some type of X-Y table as the object holder. The Examiner, however, is suggesting that it would have been obvious for the '860 Bacus patent to have an immovable object holder. The '860 Bacus patent clearly discloses that a movable stage (10) is required so that all portions of a slide can be brought under the microscope objective optics for microscopic imaging (see column 5, lines 65-67 of the '860 Bacus patent). Additionally, it is further described that the location of the stage is indexed so that all areas of the slide that have suspicious cells can be imaged for further analysis. The reference goes on to describe that the X and Y location of the stage is written into an electronic memory and this information is used to control X and Y positioning controllers of the stage so that the stage can be positioned such that the slide is in optical proximity to the objective optics for further analysis (see column 6, lines 5-24 of the '860 Bacus patent). Accordingly, one skilled in the art would not have found it to be a matter of obvious design choice to replace the movable stage (10) of the '860 Bacus patent with an unmovable object holder because such an adaptation would render the apparatus of the '860 Bacus patent inoperable for its intended purpose.

Additionally, the Examiner argues, on page 3 of the Office Action, that after controlling the X and Y controllers, the stage (10) of the '860 Bacus patent takes stationary form. However, independent claims 22 and 36 require that the object holder is immovable. Accordingly,

the combination of the '860 Bacus patent, '043 Bacus patent and the '662 Bacus patent does not teach or suggest an ***immovable*** object holder for positioning the object ***in a stationary position***.

B. No teaching or suggestion of <u>displacing</u> at least one mirror while holding the object in a stationary position

The '860 Bacus patent, the '043 Bacus patent and the '662 Bacus patent, either alone or in combination, do not teach or suggest ***displacing*** at least one mirror for selecting a part of the image from the reflected image of the object while holding the object ***stationary*** as required by independent claims 22 and 36. Each of the Bacus patents discloses the use of stationary mirrors and a movable object holder. The advantage of moving the mirrors, rather than the object, is that there is less chance of damaging the object and spilling hazardous chemicals when the object can remain stationary.

The Examiner specifically contends that the '662 Bacus patent teaches at least one displaceable mirror and points to mirrors (158, 160 and 162) disclosed therein. While the Examiner is correct that these mirrors (158, 160 and 162) of the '662 Bacus patent are rotatable, this reference only discloses that these mirrors are rotatable during initial equipment setup and are then secured by a securing means (430) to a mounting base (see column 18, lines 59-62). Therefore, the rotation of these mirrors (158, 160 and 162) cannot be considered a displacement for selecting a part of the image from the reflected image of the object as required by the independent claims.

Accordingly, the combination of the '860 Bacus patent, '043 Bacus patent and the '662 Bacus patent does not teach or suggest ***displacing*** at least one mirror for selecting a part of the image from the reflected image of the object while holding the object ***stationary***.

As set forth in §2143.03 of the Manual of Patent Examining Procedure, to establish *prima facie* obviousness of a claimed invention, ***all*** of the claim limitations must be taught or suggested by the prior art. Where claim limitations are simply not present in the prior art, the Federal Circuit has held that a *prima facie* obviousness rejection is not supported. *In re Fine*, 85 U.S.P.Q. 2d. 1596 (Fed. Cir. 1988).

As discussed above, the combination of the Bacus patents fail to teach or suggest several elements of independent claims 22 and 36, including an immovable object holder for positioning the object in a stationary position and at least one displaceable mirror for selecting a part of the image from the reflected image of the object while holding the object in a stationary position. The Examiner has used Appellant's disclosure as a blueprint to improperly combine prior art to reject the claims for obviousness. Accordingly, the Examiner has not established the asserted *prima facie* case of obviousness based on the cited references.

Additionally, it has been held that a conclusion that a claimed invention is obvious must be supported by "some articulated reasoning with some rational underpinning to support the

legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006) cited with approval in *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007). The Examiner argues that the reason for using a movable mirror in the device of the '860 Bacus patent would be to reflect a chosen part of the image to a viewing area (see page 4 of the final Office Action). However, the '860 Bacus patent discloses a moveable X-Y table to position a desirable area of the sample to a viewing area. Accordingly, there is no reason why one skilled in the art would include a moveable mirror in the system of the '860 Bacus patent. Therefore, the '860 Bacus patent teaches away from the claimed invention and the Examiner's conclusion of obviousness is not supported.

C. The Bacus patents are non-analogous art

Furthermore, the Appellant contends that the Bacus patents are non-analogous art. Pursuant to MPEP §2141.01(a), in determining whether a prior art reference is analogous, it should be determined (1) whether the art is from the same field of endeavor, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference is still reasonably pertinent to the particular problem with which the inventor is involved. In determining whether the reference is reasonably pertinent to the problem the invention intends to solve, the purpose of both the invention and the prior art are important. Thus, if a reference disclosure has the same purpose as the claimed invention, an inventor may well have been motivated to consider the reference; on the other hand, if it is directed to a different purpose, the inventor would have less motivation to consider it.

Here, the field of technology of the Bacus patents is completely different from the present invention. The field of technology of the present invention relates to the selection and recording of biotechnical samples (i.e., DNA/RNA) of a completely different size and scale than the cellular analysis techniques and apparatus disclosed by the Bacus patents. Appellant respectfully submits that one skilled in the art would not look to the cellular analysis structure of the Bacus patents when seeking to solve the problem associated with selecting and recording images of DNA, RNA or proteins. For example, the '043 Bacus patent discloses a technique for observing and recording visual information that is clearly more detailed, requiring a microscope for measurements as to the area of microns (see, for example, column 4, line 34; column 4, line 52; column 5, line 37; column 5, line 45 and column 5, lines 61-62). On the other hand, the present invention utilizes at least a millimeter scale of selecting and recording. Accordingly, the scale difference between the two fields of endeavor is entirely too great (at least approximately 10^3) for the Bacus patents to be considered reasonably pertinent to the field of the Appellant's endeavor.

Claims 24, 26-29, 31-34, 40 and 42 depend from and add further limitations to independent claims 22 and 36 or a subsequent dependent claim and are believed to be patentable for the reasons discussed hereinabove in connection with independent claims 22 and 36.

II. Rejection of claim 30 under 35 U.S.C. §103(a) as being obvious over the Bacus patents in view of United States Patent No. 5,998,796 to Liu et al.

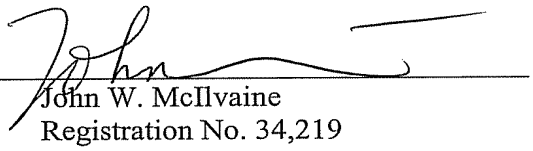
Claim 30 depends from and adds further limitations to amended independent claim 22. The combination of the '860 Bacus patent, the '043 Bacus patent and the '662 Bacus patent is discussed hereinabove in connection with amended independent claim 22. The Liu patent is directed to a detector for DNA sample identification and is provided by the Examiner as allegedly teaching a displaceable camera. The Liu patent does not cure the deficiencies of the combination of the '860 Bacus patent, the '043 Bacus patent and the '662 Bacus patent. Therefore, claim 30 is believed to be patentable for the reasons discussed hereinabove in connection with amended independent claim 22.

III. Conclusion.

Based upon the above-specified clear error, Appellant asserts that a *prima facie* rejection based on obviousness has not been established with respect to the pending claims. Accordingly, withdrawal of the above-described rejections and allowance of claims 22, 24, 26-30, 32-34, 36, 40 and 42 are respectfully requested. Any questions regarding this submission should be directed to Appellant's undersigned representative, who can be reached by telephone at 412-471-8815. The Commissioner for Patents is hereby authorized to charge any additional fees which may be required to Deposit Account No. 23-0650. Please refund any overpayment to Deposit Account No. 23-0650.

Respectfully submitted,

THE WEBB LAW FIRM

By 

John W. McIlvaine
Registration No. 34,219
Attorney for Appellant
700 Koppers Building
436 Seventh Avenue
Pittsburgh, Pennsylvania 15219
Telephone: 412-471-8815
Facsimile: 412-471-4094
E-mail: webblaw@webblaw.com